

REMARKS

Applicants are amending claims 22, 29, and 30, and canceling claim 25. Applicants respectfully submit that no new matter is being added by these amendments.

Request to Correct Inventorship

A Request to Correct Inventorship to add inventor Teng Pin Poo was filed on May 20, 2004. Applicants respectfully request that the Director issue a decision on the Request and issue an updated Filing Receipt showing both Chong Seng Cheng and Teng Pin Poo as the joint inventors.

Objection to the Specification

The Examiner objected to the title under 35 U.S.C. § 132(a) as introducing new matter. Applicants are amending the title to delete the language “Capable of Being Directly Connected Via USB Plug to a Computer.” Applicants respectfully request that the objection be withdrawn.

Rejection under 35 U.S.C. § 112

The Examiner rejected claims 22-29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse.

The Examiner stated that the specification as originally filed does not support the limitation “a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer” recited in claim 22. The Examiner also stated that the specification as originally filed does not support the limitation “said memory being non-removable from the unitary portable data storage device” recited in claim 22. On the contrary, as determined by the Board of Patent Appeals and Interferences, these limitations are supported by the as-filed specification. Decision in Appeal No. 2008-006002, Nov. 20, 2009 at pp. 4-7.

The Examiner further stated that the specification as originally filed does not support the limitation “and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD” as recited in claim 22. On the contrary, as determined by the Board of Patent Appeals and Interferences, this limitation is supported by the as-filed specification. Decision in Appeal 2008-006002, Nov. 20, 2009, pp. 7-9. Further, Applicants have amended this limitation of claim 22, so this rejection is moot.

Applicants respectfully submit that all of the limitations of claims 22-30 are supported by the as-filed specification and thus satisfy the written description requirement. Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 U.S.C. § 102(e)

Claim 22 recites a unitary portable data storage device that comprises a non-volatile solid-state memory having a memory size at least as large as the memory size of a magnetic disk or CD, and a memory controller to control storage of data in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD, the data including at least user data that is not authorization data. None of the cited references discloses a data storage device with a memory having a memory size at least as large as the memory size of a magnetic disk or CD. None of the cited references discloses a unitary portable data storage device that is able to serve as an alternative to a magnetic disk or CD. Miller discloses a security key that provides security to a host computer, and this security key does not have a memory with a memory size at least as large as the memory size of a magnetic disk or CD. Nor can the security key of Miller serve as an alternative to a magnetic disk or CD. Gilbert discloses a PDAC device that executes software as a stand-alone computer, and this PDAC is not able to serve as an alternative to a magnetic disk or CD. Gilbert also does not disclose that the

PDAC has a non-volatile solid-state memory with a memory size at least as large as the memory size of a magnetic disk or CD. Thus neither Miller nor Gilbert anticipates claims 22-24 and 26-28.

Miller

The Examiner rejected claim 22-24 and 26-28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,038,320 to Miller. Applicants respectfully traverse.

Miller discloses a security key that must be coupled to the USB bus of a specially programmed host computer in order for the user to obtain access to the computer, i.e., for the computer to successfully boot and be operational. *See, e.g.*, Miller, col. 2, lines 20-28; col. 4, lines 42-51; col. 5, lines 5-7; Fig. 6, steps 130, 140, and 170. Miller teaches using a key code and password matching scheme to prevent unauthorized access to the host computer. *See, e.g.*, Miller, col. 4, line 51- col. 5, line 9; Fig. 6, steps 150-190. The purpose of Miller's security key is to provide security to a host computer that includes a USB port by preventing a keyboard attached to the USB port from bypassing run-time security enabled by a keyboard controller. Miller, col. 2, lines 3-16. Miller discloses that only a key code and encrypted password are stored in flash memory 46. Miller, col. 3, line 4; col. 3, lines 47-50.

Claim 22 recites "a non-volatile solid-state memory . . . having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD." Miller does not disclose this limitation. The purpose of the security key of Miller is to prevent unauthorized access to a host computer. Miller only discloses that a key code and encrypted password are stored on the security key. Miller, col. 3, line 4; col. 3, lines 47-50. Miller does not disclose that the flash memory of the security key has a memory space at least as large as the memory space of a

magnetic disk or CD. Applicants respectfully submit that at the time of the invention, it was well known that a minimum memory size of a magnetic disk was approximately one megabyte. See http://en.wikipedia.org/wiki/Floppy_disk (last visited July 26, 2010). Miller does not disclose that the flash memory of the security key has a memory size of at least approximately one megabyte. Thus Miller does not disclose this limitation.

Claim 22 also recites a memory controller “to control storage of data received via the USB plug in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD, the data including at least user data that is not authorization data.” Miller does not disclose this limitation. Miller does not disclose that a memory controller that controls the storage of data received via the USB plug in the memory where the data includes at least user data that is not authorization data. Miller discloses that only a key code and encrypted password are stored in the security key (Miller, col. 3, line 4; col. 3, lines 47-50), neither of which is user data that is not authorization data received via a USB plug. Thus Miller does not disclose this limitation.

Further, the purpose of Miller’s security key is to provide security to a host computer. Miller’s security key cannot serve as an alternative to a magnetic disk or CD.

Miller does not disclose all of the limitations of claim 22. Applicants respectfully submit that claim 22 is not anticipated by Miller and is in condition for allowance. Claims 23, 24, and 26-28 depend from claim 22 and therefore allowable for at least the same reasons.

Gilbert

The Examiner also rejected claims 22-24 and 26-28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,457,099 to Gilbert. Applicants respectfully traverse.

Gilbert discloses a programmable dedicated application card (PDAC) that executes dedicated software applications stored in the PDAC. The PDAC is intended to provide protection to a software application: “Because a software application is stored in EPROM, the application cannot be tampered with or otherwise tainted.” Gilbert, col. 2, lines 18-19. The PDAC acts as a stand-alone computer system. Gilbert, col. 3, lines 20-21.

Claim 22 recites “a non-volatile solid-state memory . . . having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” Gilbert does not disclose this limitation. Gilbert does not disclose that the non-volatile memory of the PDAC has a memory space at least as large as the memory space of a magnetic disk or CD. Applicants respectfully submit that at the time of the invention, it was well known that a minimum memory size of a magnetic disk was approximately one megabyte. *See* http://en.wikipedia.org/wiki/Floppy_disk (last visited July 26, 2010). Gilbert does not disclose that the non-volatile memory of the PDAC has a memory size of at least approximately one megabyte. Thus Gilbert does not disclose this limitation.

Claim 22 also recites a memory controller “to control storage of data received via the USB plug in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD, the data including at least user data that is not authorization data.” Gilbert does not disclose this limitation. Gilbert only discloses that the PDAC stores a software application in non-volatile memory of the PDAC. There is not disclosure in Gilbert that either processor 102 or direct memory access controller 104 controls the storage of data received via the USB plug in the memory where the data includes at least user data that is not authorization data. Gilbert does not disclose that any user data is received via a

USB plug and does not disclose that any such user data is stored in a non-volatile memory of the PDAC. Gilbert only discloses that software applications are stored in EPROM 106 and a host control program (HCP) is stored in EEPROM 108. Gilbert, col. 3, lines 31-39. Thus, Gilbert does not disclose this limitation.

Further, the purpose of the PDAC of Gilbert is to execute software applications, acting as a stand-alone computer system. The purpose of the PDAC of Gilbert is not to serve as an alternative to a magnetic disk or CD.

Gilbert does not disclose all of the limitations of claim 22. Applicants respectfully submit that claim 22 is not anticipated by Gilbert and is in condition for allowance. Claims 23, 24, and 26-28 depend from claim 22 and are therefore allowable for at least the same reasons.

Rejection under 35 U.S.C § 103(a)

Claim 25

The Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of U.S. Patent No. 6,786,417 to Kondo. Applicants have cancelled claim 25, and thus this rejection is moot.

The Examiner also rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Kondo. Applicants have cancelled claim 25, and thus this rejection is moot.

Claims 29 and 30

Claim 29 depends from claim 22, which recites a unitary portable data storage device that comprises a non-volatile solid-state memory having a memory size at least as large as the memory size of a magnetic disk or CD. None of the cited references discloses a data storage device with a memory having a memory size at least as large as the memory size of a magnetic disk or CD. Margalit discloses a device that is analogous to a memory smart card, which at the

time of the invention did not have a memory size at least as large as the memory size of a magnetic disk or CD. Margalit does not disclose all of the limitations of claim 22, and so the combination of Margalit and Jha does not disclose all of the limitations of claims 29 and 30.

The Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,748,541 to Margalit in view of U.S. Patent No. 6,407,949 to Jha. Applicants respectfully traverse.

Claim 22 recites “a non-volatile solid-state memory . . . having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” Margalit does not disclose this limitation. Margalit discloses a device that is “analogous to a memory smart card.” Margalit, col. 4, lines 21-22. The memory space of a memory smart card at the time of the invention was very small (up to only 1 kilobyte) in contrast to the memory space of a magnetic disk at the time of the invention (at least approximately 1 megabyte). *See* paragraph 21 on p. 10 of the Hyde Affidavit (submitted Nov. 28, 2005); *see also* http://en.wikipedia.org/wiki/Floppy_disk (last visited July 26, 2010). Margalit does not disclose a non-volatile memory having a memory size at least as large as 1 megabyte. Thus Margalit does not disclose a non-volatile memory having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD. Margalit does not disclose all of the limitations of claim 22.

Claim 29 recites “the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection received via the USB plug.” Jha does not disclose this limitation. Jha discloses an ASIC that

includes a flash memory array 130 including flash memory cells defining up to N different flash macros which can be independently accessed. Jha, col. 7, lines 54-58. However, Jha does not disclose that each of the flash macros is selectively accessible in response to a zone selection received via a USB plug. The flash macros of the Jha ASIC are accessed according to requests from the microprocessor or other component of the ASIC itself (Jha, col. 11, lines 2-3), not from a zone selection received from outside of the ASIC. Thus Jha does not disclose this limitation.

Neither Margalit nor Jha, alone or in combination, discloses all of the limitations of claim 29. Applicants respectfully submit that claim 29 is not obvious in view of the cited references and is in condition for allowance. Claim 30 depends from claim 29 and is therefore allowable for at least the same reasons.

Conclusion

Based on the foregoing amendments and remarks, Applicants respectfully submit that all pending claims in the present application are in condition for allowance and respectfully request the issuance of a Notice of Allowance. If a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Applicants' attorney at the number listed below.

Respectfully submitted,

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